

Serial No.: 09/690,199
Response to Office Action of 06/07/2004

Docket No. 28150.7
Customer No. 000027683

REMARKS

Applicant respectfully requests reconsideration of this application in view of the following remarks. Claims 1-21 have been amended. Claims 1-21 are pending. Antecedent basis for the amendments is located throughout Applicant's specification and the original claims. Accordingly, no new matter has been entered.

Information Disclosure Statement

In the Information Disclosure Statement mailed by Applicant to the USPTO on September 10, 2002 ("IDS"), the Examiner neither initialed nor deleted the following cited reference. Accordingly, in the IDS, Applicant respectfully requests that the Examiner please initial such reference.

U.S. Provisional application No. 60/215,683, filed on June 30, 2000, having Kevin McCurdy as inventor, and entitled "Electronic Magazine System".

Rejection of the claims

The Office Action rejected claims 1, 8 and 15 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,484,198 ("Milovanovic").

As amended, claim 1 recites:

1. A method performed by a computer system, comprising:
storing a digital version of a mass-produced printed paper, wherein the digital version is displayable on a display device as a likeness of the paper; and
forming a hyperlink reference within the digital version, wherein the hyperlink reference is a hyperlink associated with an operation of the computing device and with at least a portion of the likeness of the paper, such that when version, wherein the digital version is displayed displayable on the a display device as the a likeness of the paper, and wherein the hyperlink reference's associated portion of the displayed likeness is selectable by a user to cause the computer system's performance of the hyperlink reference's associated operation.

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As amended, claim 8 recites:

8. A system, comprising:
a computing device for:

storing a digital version of a mass-produced printed paper, wherein the digital version is displayable on a display device as a likeness of the paper;
and

forming a hyperlink reference within the digital version, wherein the hyperlink reference is a hyperlink associated with an operation of the computing device and with-at least a portion of the likeness of the paper, such that when-version, wherein the digital version is displayed displayable on the-a display device as the-a likeness of the paper, and wherein the hyperlink reference's associated portion of the displayed likeness is selectable by a user to cause the computing device's performance of the hyperlink reference's associated operation.

As amended, claim 15 recites:

15. (Currently amended) A computer program product, comprising:
a computer program processable by a computer system for causing the computer system to:

store a digital version of a mass-produced printed paper, wherein the digital version is displayable on a display device as a likeness of the paper;
and

form a hyperlink reference within the digital version, wherein the hyperlink reference is a hyperlink associated with an operation of the computer system and with-at least a portion of the likeness of the paper, such that when-version, wherein the digital version is displayed-displayable on the-a display device as the-a likeness of the paper, and wherein the hyperlink reference's associated portion of the displayed likeness is selectable by a user to cause the computer system's performance of the hyperlink reference's associated operation; and

an apparatus from which the computer program is accessible by the computer system.

In MPEP § 2131, the PTO provides that:

"[t]o anticipate a claim, the reference must teach every element of the claim...."

Therefore, to sustain a rejection of claim 1, Milovanovic must contain all of the above-recited elements in claim 1. However, Milovanovic fails to teach the combination of elements in amended claim 1. Accordingly, Milovanovic does not support a rejection of amended claim 1 under 35 U.S.C. § 102(e).

In relation to amended claims 8 and 15, Milovanovic is likewise defective in supporting a rejection under 35 U.S.C. § 102(e).

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Moreover, as stated in MPEP § 2142, "...The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness..." Also, MPEP § 2142 states: "...the examiner must step backward in time and into the shoes worn by the hypothetical 'person of ordinary skill in the art' when the invention was unknown and just before it was made...The examiner must put aside knowledge of the applicant's disclosure, refrain from using hindsight, and consider the subject matter claimed 'as a whole.'" Further, MPEP § 2143.01 states: "The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination."

In relation to amended claim 1, Milovanovic is defective in establishing a *prima facie* case of obviousness. For example, as between Milovanovic and Applicant's specification, only Applicant's specification teaches the combination of elements in amended claim 1. In fact, Milovanovic teaches away from such a combination.

Milovanovic describes tag information (e.g., bar code or magnetic signature) that is physically attached by a publisher directly onto a *printed* document before the printed document is distributed to subscribers. Milovanovic teaches that the subscriber: (a) receives the printed document; (b) swipes or enters the bar code or magnetic signature into a sensing device; and (c) in response to the swipe or entry, receives a response message (containing a URL) via a network. Thus, Milovanovic's bar code or magnetic signature is clearly distinct from Milovanovic's URL.

According to Milovanovic, its URL merely "points to" a web page on the Internet. *After* the subscriber receives Milovanovic's URL, the subscriber may optionally visit the web page to retrieve an *electronic* version of the printed document. Thus, Milovanovic fails to teach anything about forming its URL *within* the *electronic* version of the printed document.

Notably, although Milovanovic's URL "points to" the *electronic* version of the printed document, Milovanovic fails to teach the reverse. For example, Milovanovic fails to teach anything in the *electronic* version of the printed document that would point to Milovanovic's URL. Thus, if Milovanovic's electronic version of the printed document is displayed, Milovanovic fails to teach anything in the *displayed electronic* version that would

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be selectable by the subscriber to cause performance of the URL's associated operation.

Clearly, therefore, Milovanovic fails to teach amended claim 1, and in fact teaches away from it. Thus, the motivation for advantageously combining the claimed elements would arise solely from hindsight based on Applicant's teachings in its own specification. Accordingly, the PTO's burden of factually supporting a *prima facie* case of obviousness has not been met.

In relation to amended claims 8 and 15, Milovanovic is likewise defective in establishing a *prima facie* case of obviousness.

Thus, a rejection of amended claims 1, 8 and 15 is not supported.

Conclusion

For these reasons, and for other reasons clearly apparent, Applicant respectfully requests allowance of claims 1, 8 and 15.

Dependent claims 2-7 depend from and further limit claim 1 and therefore are allowable.

Dependent claims 9-14 depend from and further limit claim 8 and therefore are allowable.

Dependent claims 16-21 depend from and further limit claim 15 and therefore are allowable.

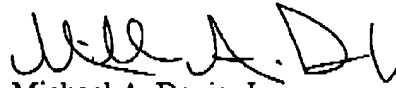
An early formal notice of allowance of claims 1-21 is requested.

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Applicant has made an earnest attempt to place this case in condition for allowance.
If any unresolved aspect remains, the Examiner is invited to call Applicant's attorney at the telephone number listed below.

Respectfully submitted,



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